

JP920000220US1

Application No.: 09/666,230
Filing Date: 09/21/2000**STATEMENT REGARDING COMMON OWNERSHIP**

The present patent application and U.S. patent No. 6,424,997 B1 ("Buskirk, Jr.") were, at the time the invention of the present patent application was made, owned by the International Business Machines Corporation. See also item 2 in "Other Remarks" herein below.

OTHER REMARKS

1. **Indefiniteness Rejections.** Claims 1 through 34 were presented in the subject patent application. In the first Office action, dated January 9, 2004, all the claims were rejected under 35 U.S.C. 112, second paragraph.

Applicant contends that the amendments submitted herein overcome the 35 U.S.C. 112 based rejections. Specifically, claims 3-5, 7, 9 and 11; 15-17, 19 and 22; and 26-28, 30 and 33 are herein canceled. Amendments to the remaining claims are herein submitted. In particular, the numerous terms and phrases in the original claims that stand rejected on grounds of insufficient antecedent basis have been amended to provide proper antecedent basis, or else the terms or phrases have simply been deleted. Likewise, the numerous terms and phrases in the original claims that stand rejected on grounds of indefiniteness have been either deleted or replaced by definite terms and phrases.

Further, in addition to claims 6, 18 and 29 being amended herein to overcome the subject 35 U.S.C. 112 rejections, certain matter is herein canceled from these claims and set out instead in new claims 35-38, 39-42 and 43-46, respectively, in amended form to provide proper antecedent basis and avoid indefiniteness.

No new matter is added by any of the above described amendments, since the original claims and specification provide support for the amendments. The support for most of the amendments is clear on the face of the claims. For example, "the electronic mail headers" is amended to read "headers of the e-mails," etc. Support for others of the amendments may not be quite so clear on the face of the claims; however, the original specification provides support for these amendments. See page 19, lines 26-28 (regarding identifying when reply templates are to be prepared for responses to respective ones of the e-mails); page 20, lines 15-20 (regarding the

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reply templates being for completion by a user preparing the responses to the e-mails); page 19, lines 1-6, page 19, line 29 - page 20, line 13 and page 21, lines 6-17 (regarding storing the received e-mails and parsed senders, subjects and keywords in the PED); page 20, lines 7-13, and page 22, lines 1-6 (regarding the preparing of the reply templates including the extracting of certain content of the e-mails for including in ones of the reply templates); page 19, lines 1-6, page 19, line 29 - page 20, line 13 and page 21, lines 6-17 (regarding storing the parsed senders, subjects and keywords in a New Knowledge Base (NKB) in the PED); page 19, lines 10-11 (regarding the identifying when to prepare a reply template including selecting among i) preparing the reply template immediately, ii) preparing the reply template at some future time, and iii) not preparing the reply template); page 28, lines 10-11 (regarding the identifying when to prepare a reply template being responsive to whether one of the received e-mails specifies a Cc address); page 28, lines 8-9 (regarding the identifying when to prepare a reply template being responsive to a length of one of the received e-mails); page 27, lines 3-10 (regarding the categorizing of the e-mails including identifying lengths of the e-mails, and the analyzing to extract certain content of the e-mails being responsive to a length of one of the received e-mails); and page 28, line 21 (regarding selecting certain types of the contents of the e-mails to be included in the reply templates responsive to age of the e-mails).

Other than the discussion in the Detailed Action of the Office action regarding 35 U.S.C. 112 rejections, the Office action provides no further basis for rejection of claims 6, 8, 18, 20, 29 and 31. Applicant contends, therefore, that claims 6, 8, 18, 20, 29 and 31, as amended, are allowable. Furthermore, since new claims 35-38, 39-42 and 43-46 set out aspects of original claims 6, 18 and 29, Applicant contends that these claims are also allowable.

2. Obviousness Rejections. Claims 1-2, 7, 9-14, 19, 21-25, 30 and 32-34 were also rejected under 35 U.S.C. 103 (a) in the first Office action, as being unpatentable over Buskirk, Jr. in view of U.S. patent No. 6,609,138 B1 ("Merriam"). However, as stated herein above, the present patent application and Buskirk, Jr. were, at the time the invention of the present patent application was made, owned by the International Business Machines Corporation. Furthermore, Buskirk, Jr. only qualifies as prior art under 35 U.S.C. 102(e), (f) or (g); the present application was filed after November 29, 1999; and Buskirk, Jr. is applied solely in an obviousness rejection under 35 U.S.C. 103(a). For these reasons Applicant contends that Buskirk, Jr. is disqualified as

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a reference. At least because Buskirk, Jr. is disqualified as a reference, Applicant contends that the amended 1-2, 8, 10, 12-14, 18, 20, 23-25, 29, 31 are 34 claims, as amended, are patentable over the remaining references cited.

Applicant chooses not to comment on other possible reasons for allowability of these claims, since the Buskirk, Jr. patent is disqualified as a reference. The amended claims may also be patentably distinct for other reasons as well. Applicant's lack of further comment should not be construed as a lack of other reasons for patentable distinction of the amended claims over the combination of Buskirk, Jr. and the other art cited. That is, Applicant's lack of further comments should not be construed as an admission of any kind regarding other reasons for patentable distinction of the amended claims over the combination of Buskirk, Jr. and the other art cited.

Also, new claims 35-38, 39-42 and 43-46 are allowable because they depend on claims 1, 13 and 24, respectively, in addition to the reasons for allowability set out in the section herein above discussing 35 U.S.C. 112 based rejections.

PRIOR ART OF RECORD

Applicant has reviewed the prior art of record cited by but not relied upon by Examiner, and asserts that the invention is patentably distinct.

REQUESTED ACTION

Applicant contends that the invention as amended is patentably distinct, and hereby requests that Examiner grant allowance and prompt passage of the application to issuance.

Respectfully submitted,

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